

**REMARKS**

**I. STATUS OF CLAIMS**

Claims 1-69 are pending. Claims 58-65 and 67 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being drawn to a non-elected invention.

Claims 3-11 have been amended and double brackets have been used to clarify that the "left hand side ratio" in claims 3-11, and the "bicarbonate having [an] equal sign" in the last two lines of claim 3, have been deleted from the claims. Claims 12-16, 26, and 37 have also been amended. Support for these amendments can be found in the original specification and claims.

In addition, claims 1, 66, 68, and 69 have been amended. The composition of claim 1, and the products of claims 66, 68, and 69, as amended, comprise, *inter alia*, "(i) at least one coloring agent component . . . (ii) a component (B) comprising at least one acidic composition; and optionally, (iii) a component (C) comprising at least one alkaline composition." Support for the amendments can be found, for example, at paragraphs [015] and [016] of the present specification. The specification provides written description support for the claim amendments and newly presented claims.

**II. PRIORITY**

The Examiner has not accorded Applicants benefit of their earlier filed provisional application under 35 U.S.C. § 119(e) because she asserts that the certified statement accompanying the English-language translation of the provisional application which was filed at the U.S. Patent and Trademark Office ("USPTO") on September 5, 2008, does

not identify the provisional application by its application number. Office Action at p. 2. The Examiner also indicates that the certified statement accompanying the English-language translation of the foreign priority document which was filed on September 5, 2008, is not proper because it does not identify the foreign priority document by its application number. *See id.*

Applicants are not aware of any USPTO rule that requires the translator's certified statement to identify the translated document by number. However, in the interest of advancing prosecution, Applicants submit herewith a certified English-language translation of foreign priority document, FR 02 15051, wherein the translator's certified statement identifies the translated document by its application number, FR 02 15051. Applicants also re-submitted a copy of the certified English-language translation of the provisional application with a certified statement that identifies the provisional application by its number, U.S. Provisional Application No. 60/507,119. A copy of the electronic filing receipt confirming the filing of the certified English-language translation in U.S. Provisional Application No. 60/507,119 is submitted herewith as Exhibit 1. Applicants submit that the foreign priority document, FR 02 15051, and the provisional application, U.S. Provisional Application No. 60/507,119, provide written description support for all the pending claims.

In view of the foregoing, Applicants respectfully request that the Examiner acknowledge receipt of the certified translations and accord Applicants the benefit of priority under 35 U.S.C. § 119.

### **III. INFORMATION DISCLOSURE STATEMENT**

On September 23, 2008, the Examiner returned the IDS Form PTO/SB/08 ("Form") filed March 11, 2008. At the bottom of the Form, the Examiner states that "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH." The Examiner has crossed out two of the foreign patent documents, JP 11-92347 and JP 2002-332222, listed on the Form. However, the Examiner has considered the corresponding English-language Derwent abstracts provided for JP 11-92347 and JP 2002-332222. Applicants submit that the Examiner therefore should have considered, rather than crossed out, the corresponding foreign patents, JP 11-92347 and JP 2002-332222. Accordingly, Applicants respectfully request clarification why JP 11-92347 and JP 2002-332222 were crossed out in the PTO/SB/08 Form.

### **IV. REJECTIONS UNDER 35 U.S.C. § 112**

#### **A. Rejection under 35 U.S.C. § 112, second paragraph**

The Examiner maintains the rejection of claims 3-11 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action at p. 3.

The Examiner asserts that there are two formulae for the ratios in claims 3-11. *Id.* The Examiner recognizes that the ratio on the "right hand side," where the bicarbonate anion has a negative charge, is the corrected formula and the "left hand side ratio" is not the corrected formula. *See id.* Applicants have deleted the "left hand side ratio" from claims 3-11. This deletion is shown using double brackets since the deletion was not easily perceived by using strike-through in the Amendment and Reply to Office Action under 37 C.F.R. § 1.116 filed on September 5, 2008 ("Amendment").

In addition, the Examiner asserts that “the last two lines of claim 3, recite bicarbonate having [an] equal sign instead of [a] negative charge.” Office Action at p. 3. Applicants have deleted the bicarbonate which appears to have an equal sign and replaced it with bicarbonate having a negative charge.

In view of the amendments, Applicants submit that the rejection is rendered moot. Accordingly, Applicants respectfully request that the Examiner withdraw the § 112, second paragraph rejection.

#### **V. REJECTIONS UNDER 35 U.S.C. § 103**

The Examiner maintains the rejection of claims 1-41, 50-53, 66 and 68-69 under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of WO 02/30375 to Pruche (“Pruche”) and U.S. Patent No. 6,736,861 to Patel et al. (“Patel”), for the reasons of record. Office Action at pp. 3-5.

In the Amendment filed September 8, 2008, Applicants argued that Pruche teaches that its’ compositions have the advantage of not requiring the use of hydrogen peroxide. Thus, Pruche teaches away from the claimed invention.

In response, the Examiner contends that “Claim 1 does not recite that the composition has both the acidic and basic composition.” Office Action at p.5 (emphasis in original).

In other words, the Examiner was not persuaded by Applicants’ arguments because the composition of claim 1 did not necessarily include component (B) comprising at least one acidic composition.

Claim 1, as amended herein, states in pertinent part "(i) at least one coloring agent component . . . (ii) a component (B) comprising at least one acidic composition; and optionally, (iii) a component (C) comprising at least one alkaline composition." Thus, the composition of claim 1 recites both at least one acidic composition and at least one coloring agent component. Claims 66, 68, and 69 have been amended in a similar manner.

Consequently, in view of the amendments provided herein and the arguments already of record, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request that the Examiner withdraw the rejection with respect to claims 1-41, 50-53, 66 and 68-69 .

## **VI. DOUBLE PATENTING REJECTION**

The Examiner maintains the rejection of claims 1-41, 50-53, 66 and 68-69 for obviousness-type double patenting over claims 1-32 of U.S. Patent No. 6,953,486 to Pruche ("Pruche") in view of U.S. Patent No. 6,736,861 to Patel et al. ("Patel") for the reasons of record. Office Action at p. 5.

As discussed in Section V above, Pruche teaches away from including hydrogen peroxide, i.e, an acidic component, in a coloring composition. The composition of claim 1, and the products of claims 66, 68, and 69, as amended, recite, *inter alia*, "(i) at least one coloring agent component . . . (ii) a component (B) comprising at least one acidic composition . . . ." Such an acidic composition includes hydrogen peroxide.

Accordingly, in view of the amendments provided herein and the arguments already of record, the claimed invention would not have been *prima facie* obvious over

the combination of Pruche and Patel. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the obviousness-type double patenting rejection.

## VII. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 17, 2009

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### Attachments:

- Exhibit 1:** Electronic filing receipt dated February 17, 2009, confirming filing of the certified English-language translation in U.S. Provisional Application No. 60/507,119.
- Exhibit 2:** Certified English-language translation of foreign priority document, FR 02 15051.